

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
(Attorney Docket No. 8970.95071)

In re U.S. Patent Application of)	
Wang et al.)	
)	
Application No.: 10/687,471)	
)	Group Art Unit: 1791
Filed: October 15, 2003)	
)	Examiner: Monica A. Huson
For: COLD WATER SOLUBLE EXTRUDED)	
STARCH PRODUCT)	Confirmation No. 8885
)	
)	

Commissioner for Patents
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REPLY TO EXAMINER'S ANSWER

This is a reply to the Examiner's Answer mailed August 24, 2009.

On page 4, the Examiner acknowledges the decision of the Board in 09/863,928, but asserts that this decision "does not necessarily apply to the product-by-process claims of the instant application. The Examiner is simply wrong. Her rejection is both erroneous on the merits and foreclosed by the prior decision of the Board.

Contrary to the Examiner's assertions, Nakatsuka does not clearly disclose a "starch product," and the rejection fails on this ground alone. It is not relevant that the starting material is starch; what matters is the final product. The Examiner gives an example wherein she describes a cake as being an "egg product" because the cake is made using eggs. By the Examiner's reasoning, a starch product that has been completely hydrolyzed to form sugar would be a "starch product." If the sugar were placed into an incinerator and burned to form water and carbon dioxide, these incineration products, according to the Examiner's reasoning, also would be "starch products." Goat cheese prepared from goat's milk from a goat that had eaten the starch would also be a "starch product" under the Examiner's logic. Plainly, the Examiner is wrong.

The claims call for a gelatinized starch product. Of course, gelatinization is a term that refers to starches, and it is not clear whether the product disclosed by Nakatsuka is in fact a starch at all, much less whether this product is capable of gelatinization. (This is another reason why the Examiner's cake analogy fails. It is possible to make a "poached egg," but once the egg has been used in baking a cake, it cannot be poached.) The Examiner states that "how the product is formed is not given weight during examination of product-by-process claims." This is wrong, because the claims specify a gelatinized starch and the product of Nakatsuka has not been shown to gelatinize.

Subsequently, the Examiner maintains that "Nakatsuka shows a gelatinized starch product as claimed, especially at column 6, lines 14 to 33." The Examiner already lost this argument in connection with the previous appeal, where the Board held that:

we agree with Appellants that the Examiner has offered no reasoning, nor pointed to any evidence of record, indicating that the starch-protein composition Nakatsuka's Example 1 undergoes gelatinization.

It is improper for the Examiner to maintain the rejection given the prior decision of the Board, which collaterally estops the Examiner.

With regard to solubility, as stated in the opening brief, Nakatsuka's teachings as to solubility are not at all certain. Nakatsuka teaches some solubility data, but teaches that "protein coagulant" may be added to vary the degree of solubility. Nakatsuka also teaches an embodiment in which the product is said to swell, not dissolve. The reference fails for this independent reason, because it lacks the requisite certainty to support a Section 103 rejection.

In combining Nakatsuka with the Redding Jr. reference, the Examiner is overlooking the teaching of both references. Incredibly, the Examiner asserts that the Nakatsuka is not concerned with modifying starch. In this, she ignores that the entire purpose of Nakatsuka is to alter the starch by combining it with a protein to form a starch-protein complex. The reference simply cannot be read any other way. In sharp contrast, the Redding Jr. reference teaches to avoid starch modification. These references are not compatible with each other.

With regard to claim 4, this claim is directed towards the particle size of the product. For this, the Examiner relies on the Altieri reference. This rejection fails, however, because in order to find the specific moisture level the Examiner would have to ignore other parts of Altieri that relate to particle size. As stated in the opening brief, Altieri teaches away from the subject matter defined by claim 4 and is not of use in any rejection thereof. It is not proper for the Examiner to pick one favorable detail out of a reference while ignoring the rest of the reference.

Once again, Nakatsuka teaches a "complex" in which "some degree of union has been established between both materials [starch and protein] by chemical reaction." What is this material? Is it a starch? Does it have any polymeric carbohydrate structure? Is it capable of gelatinization? What would the gelatinization temperature of this material be? Is the product soluble? The Examiner cannot say.

Most significantly, the Examiner already lost on these grounds in connection with the previous appeal. The previous appeal governs this application and compels reversal of all of the claim rejections.

Respectfully submitted,

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